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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/509,725 | 03/29/2000 | Seok-Keun Koh | P/2292-29 | 9859 |

2352 7590 12/31/2002

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

MAYEKAR, KISHOR

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1741

DATE MAILED: 12/31/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/509,725

Applicant(s)
S. Koh et al.

Examiner
Kishor Mayekar

Art Unit
1741



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply, and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 30, 2002
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-32 is/are pending in the application.
- 4a) Of the above, claim(s) 2-19, 22, and 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 20, 21, 23-26, 28, and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-911) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No. 11 & 12 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 20, 21, 25, 26 and 28 stand rejects under 35 U.S.C. 103(a) as being unpatentable over HAQUE et al. (4,598,022) in view of Applicant's admission, for reasons as of record.
3. Claim 24 stands rejected under 35 U.S.C. 103(a) as being unpatentable over HAQUE '022 in view of Applicant's admission as applied to claims 1, 20, 21, 25, 26 and 28 above, and further in view of HAQUE et al. (4,588,641), for reasons as of record.
4. Claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over

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HAQUE '022 in view of Applicant's admission as applied to claims 1, 20, 21, 25, 26 and 28 above, and further in view of KLEEGER et al. (5,089,290), for reasons as of record.

Double Patenting

5. Claims 1, 23-25, 28 and 29 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 35-37, 40 and 42 of copending Application No. 09/529,052, for reasons as of record.

Response to Arguments

6. Applicant's arguments filed October 29, 2002 have been fully considered but they are not persuasive.

In response to Applicant's argument on the rejection on grounds of provisional

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obvious-type double patenting, it is noted that the claims of the present application and that of the other application are not related to a restriction requirement: the former is based on a 371 of PCT/KR98/00372 and the later on a 371 PCT/KR98/00398.

In response to Applicant's argument that HAQUE '022 does not teach a polymer film with hydrophilicity or hydrophobicity on a surface of a metal, first it is noted that since claim 33 does not recite the above limitation, it is irrelevant whether HAQUE '022 includes this feature or not. Second, it is noted that since HAQUE '022 discloses in col. 3, lines 42-52 that the nature of the formed polymer film will depend upon the type of organic species used and whether both nitrogen and hydrogen are used, and since it is known that a polymer surface is either hydrophilic or hydrophobic, hence HAQUE '022 contemplates the above limitation.

In response to Applicant's argument that HAQUE '022's substrate is not one of the electrodes, it is noted that a metal substrate becomes an electrode when it is connected to an electrical power source, and since in Example II, HAQUE '022 shows

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that the metal substrate is placed on an anode, HAQUE '022's metal substrate is an anode as it is directly connected to negative terminal of a power source.

As to the argument that HAQUE '022 discloses the preference of an AC source over a DC source, it is noted that "disclosure of reference must be considered for what it fairly teaches one of ordinary skill in the art, pertinence of non-preferred disclosure must likewise be reviewed in such light", *In re Meinhardt*, 157 USPQ 270. And further, because it has been held that nonpreferred embodiments can be indicative of obviousness, *Merck & Co. V. Biocraft Laboratories Inc.* 10 USPQ 1843; *In re Lamberti* 192 USPQ 278; *In re Kohler* 177 USPQ 399; *In re Mills* 176 USPQ 196; *In re Boe* 148 USPQ 507; *In re Nehrenberg* 126 USPQ 383. Here, HAQUE '022 discloses that the DC source can be used.

To the argument on the concentration of the non-polymerizable gas, since HAQUE '022 discloses in col. 10, lines 41-45 that the organic species in gaseous form can be premixed with nitrogen and/or hydrogen, since HAQUE '022 also discloses in col. 3, lines 42-45 that the nature of the formed film will depend upon the type of organic species used and whether both nitrogen and hydrogen are used, the selection

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of the concentration would have been within the level of ordinary skill in the art.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

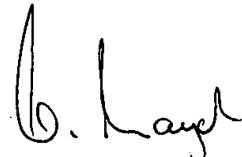
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703) 308-0477. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on (703) 308-3322. The fax phone number for this Group is (703) 872-9310 (non-after finals) or 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Kishor Mayekar
Primary Examiner
Group 1700

KM

December 21, 2002